

From johnsh@hevanet.com Fri Nov 22 11:16:12 1996
Date: Fri, 22 Nov 1996 08:00:00 -0800
From: John Smith-Hill <johnsh@hevanet.com>
To: regreform@art.uspto.gov
Subject: 1996 Changes to Patent Practice and Procedure

I have attached to this message a file COMMENTS.TXT containing in DOS text form my comments on the proposed rule changes published in the Federal Register of September 23, 1996.
Thank you for considering my comments.
- John Smith-Hill

[Part 2, Text 76 lines]
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COMMENTS

The following comments are offered regarding the 1996 changes to Patent Practice and Procedure published in the Federal Register on September 23, 1996.

There appears to be an error in the second sentence of proposed Rule 1.53(b)(1)(i) (starting "A newly executed oath..."): should there be a closing parenthesis after "paragraph (d) of this section?"

The addition to paragraph (d)(1) of Section 1.53 is rather convoluted with multiple layers of clauses within clauses. The noun for which the pronoun "which" (in "which may be a copy...") stands should be the last noun of the preceding clause, but clearly this is not the case. The awkwardness of the construction is compounded by the fact that "oath or declaration" is part of the compound noun phrase "the appropriate filing fee or oath or declaration" and clearly "which" does not stand for "the appropriate filing fee."

If the Patent and Trademark Office is truly interested in reducing the regulatory burden on the American public, it should address not only simplification of its internal procedures for handling of continuation applications but also the underlying cause for filing continuation applications. In my experience, most continuation applications are filed because the applicant wishes to continue prosecution after the examiner has issued a final rejection. The current procedure for issuing a final rejection on the examiner's second action is based on the assumption that an issue can be reached for appeal after only one Office Action and one response. That this is unrealistic is amply demonstrated by the large number of continuation applications that are filed in order to continue prosecution before the examiner.

When the term of a patent ran from the date of issue and the fee for filing a patent application was rather small, an applicant did not have a great deal of incentive to reach an issue for appeal, and could change position with regard to distinctions over the prior art, by arguing in response to one rejection that feature X distinguishes over the prior art and, in response to the next rejection, which shows feature X, replacing feature X with feature Y and arguing that feature Y distinguishes over the prior art. Compact prosecution, whereby the second Office Action was normally made final, was a reasonable response to this practice. However, now that the official filing fees are quite substantial and the end of the patent term is calculated from the application's effective filing date, an applicant has an incentive to avoid delay in prosecution and either accept the claims that the examiner deems allowable or narrow the issues for appeal as quickly as possible. I submit that an applicant who is

attempting in good faith to reach a point in prosecution at which he or she is willing to appeal rather than sacrifice more

verage should not be cut off by a final action which forces the applicant to either appeal claims that are not yet ready for appeal or file a continuation application. Good faith on the part of an applicant can be inferred from narrowing the claims under prosecution. I therefore suggest that the Office should change its procedures so that a rejection will not be made final so long as the applicant continues to narrow the claims.

I recognize that this change in procedure would deprive the Office of substantial fee income. This impact could be ameliorated by adopting a more stringent approach to restriction requirements with respect to claims that are in the same statutory class.

Numerous patents are issued containing several independent claims in the same statutory class, e.g. process. Frequently, these independent claims distinguish over the prior art with different respective points of novelty. Claim 1 might recite the steps A + B and claim 2 might recite steps A + C where A is known and B and C are novel but are different. Claim 1 would be infringed by a process that would not infringe claim 2, and vice versa. In this case, the patent owner receives, in effect, two patents but pays only one issue fee and one set of maintenance fees. I suggest that the Office should change its procedures and allow multiple independent claims in the same statutory class only if one allowable independent claim is broader than all the others.

These suggestions would not necessitate any change in PTO rules and would avoid the need for additional rules providing for the continued prosecution application